

### **Rejection of Claims 21 and 23 for new matter**

Claims 21 and 23 were rejected under 35 U.S.C. 132 as containing new matter.

Claims 21 and 23 recite that the photographic print comprises plastic print material. The specification on page 5 describes the print material used as “a durable nine millimeter thick white-pigmented thick-based polyester that provides for exceptional durability.” This passage describes plastic print material. Accordingly, there is support in the original specification for the recitation of plastic print material. The new matter rejection of claims 21 and 23 is traversed.

### **Rejection of Method Claim 1**

The Examiner rejected method claims 1-3, 21, and 22 as obvious over Travis in view of Becker or Davey. Independent claim 1 is directed to a method of creating a flooring surface. Claims 2, 3, 21, and 22 ultimately depend from claim 1. At a fundamental level, the rejection of these method claims is flawed. First, as discussed in detail below, the composition used in the claimed method of creating a flooring surface is not an obvious combination of elements. In particular, a flooring surface comprising the combination of a photographic print and a protective coating defining a barrier is not disclosed or suggested in the prior art. Applicant will elaborate on this point below. Secondly, however, with respect to method claims 1-3, 21, and 22, the law is clear that “[e]ven if a composition is old, a process using a known composition in a new and unobvious way may be patentable. *Loctite Corp. v. UltraSeal Ltd.*, 781 F.2d 861, 875 (Fed. Cir. 1985). *See also, In re Dillon*, 892 F.2d 1554, 1570 (Fed. Cir. 1989)(“In evaluating the patentability of [applicant’s] method claims it is not pertinent whether the

composition themselves are known or new or unobvious. The issue is solely whether the utility discovered by [applicant] . . . would have been obvious in light of the prior art.”).

Thus, it is immaterial whether the composition itself used in the pending method claims is old or obvious. The only issue is whether using the composition in the method of creating a flooring surface is obvious. In this case, it is clearly unobvious. The Office Action has provided no prior art which even remotely suggests using a photographic print to create a flooring surface, and certainly provides no teaching of any kind for using a composition of a photographic print and a protective coating defining a barrier in creating a flooring surface. In fact, using a photographic print to create a flooring surface is counterintuitive. Photographic prints are typically fragile and prone to wrinkling and tearing if subject to contact. Until the present invention, no one had thought of the idea of using a photographic print as part of a flooring surface. Consequently, the law allows for the patenting of a new method using a composition even if the composition of matter is not new. Accordingly, the Office Action has failed to provide prior art that teaches or discloses using a photographic print in creating a flooring surface. As a result, the Office Action fails to provide a *prima facie* case of obviousness and the rejection of method claim 1 and dependent claims 2, 3, 21, and 22 is traversed.

#### **Rejection of Independent Claims 1, 7, 16, and 26**

The Examiner rejected independent claims 1, 7, 16, and 26 under 35 U.S.C. 103 as obvious over Travis in view of Becker or Davey. These claims variously recite a flooring surface or floor tile comprising a photographic print and a protective coating defining a barrier to prevent injury to the print from foot traffic and other objects passing

over the floor tile. The Examiner acknowledges that Travis does not teach a photographic print in combination with a protective coating such as a transparent vinyl coating to prevent injury to the photographic print. (Paras. 19, 23). While the Office Action recites art that discloses the use a vinyl barrier layer for use with a floor tile, the Office Action fails to provide prior art that discloses or suggests the combination of a photographic print with a protective coating such as vinyl defining a barrier to foot traffic. Moreover, there is no teaching or disclosure of using a photographic print as part of a flooring surface. The Office Action impermissibly uses hindsight construction to combine a photographic print with a protective coating defining a barrier to prevent injury from foot traffic as part of a flooring surface or floor tile. However, there is no suggestion, motivation, or teaching anywhere in the prior art to do so. As noted above, it is counterintuitive, and thus non-obvious, to use a photographic print as part of a flooring surface because of the fragile nature of typical photographic print material. Despite this counterintuitive combination, the Office Action states the combination would be obvious, yet cites no prior art in support of such a combination. Simply stated, prior to the present invention, the idea for using a photographic print as part of a flooring surface did not exist. It is respectfully requested that the rejection of independent claims 1, 7, 16, and 26 and the claims depending therefrom is traversed.

#### **Rejection of Claims 21-24**

The Examiner rejected claims 21-24 under 35 U.S.C. 103 as obvious over Travis in view of Becker or Davey. Claims 21 and 22 are method claims that depend from claim 1. As noted above in the discussion of claim 1, a new use of an old composition may be

patentable. Thus, it is immaterial that the film material is conventional or commercially available. Moreover, claims 21-24 recite that the photographic print is comprised of either plastic or polyester-based print material. The Office Action provides no teaching or suggestion to combine plastic or polyester-based print material with a protective coating defining a barrier to prevent injury from foot traffic. Moreover, there is no teaching or suggestion to use such plastic or polyester-based print material as part of a flooring surface or floor tile. As noted in the specification on page 5, the use of polyester-based print material provides for exceptional durability. When combined with a protective coating defining a barrier to prevent injury from foot traffic, a useful flooring surface results. Thus, the plastic or polyester-based print material is durable to the point where it can serve as a component of a flooring surface or floor tile. With a thickness of 9 millimeters, the print material is particularly useful as a component of a flooring surface or floor tile.

#### **Rejection of claim 20**

Claim 20 is directed to a flooring surface comprised of a plurality of photographic prints affixed to the floor in combination to create a simulation of an object. The Office Action provides no prior art wherein a plurality of photographic prints are affixed to a floor in combination to create a simulation of an object.

#### **Rejection of claims 28-29**

Claims 28 and 29 are directed to a floor tile used to create a simulation of either a retail product or a company logo. Applicant disagrees with the Office Action and

contends that the subject matter of the photographic print is not merely a matter of design choice. As noted in the specification, the ability to provide a floor tile containing an enlarged reproduction of a company logo or simulation of a retail product eliminates the need for a retailer to use a merchandising display. Thus, the floor tiles serve a particular purpose.

#### **Rejection of claims 30-31**

Claims 30 and 31 are directed to a floor tile creating a simulation of an object (claim 30) or a simulation of an actual floor covering or ground terrain (claim 31). Applicant again disagrees with the Office Action and contends that the subject matter of photographic print is not merely a matter of design choice. The use of a floor tile simulating an object or floor covering eliminates the need to provide that object or floor covering as part of a display or decor. For example, a photographic floor tile of a marble floor or Persian rug eliminates the need to buy or provide such a marble floor or Persian rug. Heretofore, this was not possible. The use of a photographic floor tile containing a simulation of an object or floor covering provides new and useful avenues for creating a display or decor. This ability did not exist in the prior art.

#### **Conclusion**

In sum, it is respectfully submitted that the rejections of independent claims 1, 7, 16, and 26 have been traversed. In addition, the rejection of dependent claims 2, 3, 10-15, 17-25, 27-31 has been traversed. Thus, the application is condition for allowance and

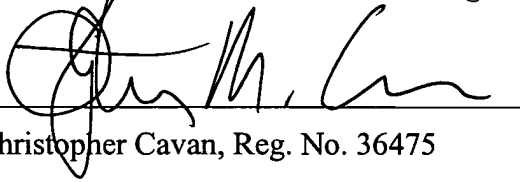
notice to that effect is solicited. If, for any reason, the Examiner is unable to allow the application and feels a telephone conference would be helpful to resolve any remaining issues, the Examiner is requested to call the undersigned attorney at 312-913-2131.

Respectfully submitted,

**McDonnell Boehnen Hulbert & Berghoff**

Dated: 5-8-98

By

A handwritten signature in black ink, appearing to read "Chris M. Cavan", written over a horizontal line.

Christopher Cavan, Reg. No. 36475

Attorney for Applicant